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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,151	01/15/2002	Robert C. Lehr	100201014-1	8861

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/045,151

Applicant(s)

LEHR ET AL.

Examiner

Michael J. Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 47 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 47 claims that hardware is on a digital site. While hardware can contain the code for a digital site, it cannot be on a digital site as the site is digital and hardware is corporeal. As such, claim 47 will not be examined on the merits as the examiner cannot ascertain exactly what is meant.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1,2,9,13,18-25, 27,29-31,35,37,39,40,45,46 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by telephone companies, including Bell Telephones (so-called, Ma Bell).

As to claims 1,27,37,45 it is old and well known for telephone companies to provide one or more hardware products (telephones), a metering mechanism coupled to the hardware products that acquires metrics data from the hardware product, the metering data determines data to report on the operation of the products and generates reports, The metering mechanism is inherent in that bills are generated based on telephone usage and these inherently come from metering.

As to claims 2,18, by definition, telephones are coupled to a communications network, the bills are based on usage.

As to claim 19,20,35 the billing information is collected at the telephone company and not the telephone.

As to claims 9,22,39, it would be inherent that there are rules used to determine the bill, such as "rate for long distance".

As to claim 11, as best understood, the metrics are provided on a periodic basis (generally, billing cycles were in one month periods).

As to claims 13,29,46, until the break-up of Bell Telephone, the phones were owned by the telephone company and therefore, leased to the user who was billed.

As to claim 21, the telephone company expects to be paid.

As to claim 23, the usage is inherently compared to a pricing plan else the user could be charged a long distance rate for a local call.

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As to claim 24, the charge inherently changes relative to usage.

As to claim 25, the metrics data are inherently determined based on business rules (such as, the cost of a long-distance call over a particular area).

As to claim 30, it is inherent to receive an inquiry from the lessee (asking to have phone service connected).

As to claims 31,40, the bills sent to the customer display usage data and have an envelope for returning payment.

As to claims 50,51, the usage report is included in the phone bill and presented to the user.

Claims 1-4,8-12,16,18-25,27,28,32,35,37-41,44,45,48 and 50-54 are rejected under 35 U.S.C. 102(b) as being anticipated by US PAT 5,745,884 to Carnegie et al. (Carnegie).

As to claims 1,18,19,20, 27,37,45, Carnegie discloses a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53-56), a metering agent that acquires metric data (306,316, as best seen in fig 3), and a usage repository that generates reports on the received data (308, 318).

As to claim 53, the device would be at the central server and therefore would not be at the device, a processor controls the operation (fig 1).

As to claims 2,39, the system generates and sends bills (308,318).

As to claims 3,21,40,50,51, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

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As to claims 4,48, Carnegie discloses a validation server (fig 3, it validates the data in that it checks to see who should be billed), a usage database (where the account info is and to which is added billing data, 308,318), it would inherently ensure that the hardware is correctly configured else it could not use the network.

As to claim 8,28,44,52 the hardware devices collect the metric data that is also acquired by the metering device (claim 5), it would inherently use software to do so.

As to claims 9,22,39, there are rules to be used to determine the data (fig 3).

As to claims 10,38, the system polls the hardware to determine to acquire metrics data (to check if the user has an account).

As to claims 11,41, the data is provided on a periodic basis (claim 7).

As to claims 12, a CPU is used (fig 1).

As to claims 16,35, the metering mechanism and usage repository are not at the same site as the device.

As to claims 22, the usage reports are based on applying rules (fig 3).

As to claims 23, it would be inherent that the usage reports are compared to pricing schemes as the pricing schemes affect the billing.

As to claims 24, it would be inherent that the rate is affected by the plan.

As to claims 25, as the rules are used by a business, they would inherently be "business" rules.

As to claims 32,48, the operating data is verified (to ensure that the user has an account), verifying an approved configuration (fig 3) that would inherently be saved, saving the operating data (316).

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As to claim 54, Carnegie discloses encrypted, compressed data (219,222, as best seen in fig 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-7, 13-15,26, 29-31,33,34,36,42,43,46,49 and 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carnegie.

As to claims 5-7, the actual make-up of the various components would not make the invention patentably distinct as these are all well-known computer variations.

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As to claim 13, Carnegie does not, however, teach leasing the equipment. However, it is old and well known in the art to lease equipment. Therefore, it would have been obvious to one of ordinary skill in the art to lease the equipment to ensure that your customers could have the necessary equipment with a minimum of investment on their part.

As to claims 14,33, the location of the devices would not make the invention patentably distinct as they are merely a matter of obvious design choice.

As to claims 15,34,36, Carnegie discloses using the Internet (fig 1), therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to ease retrieval of information.

As to claim 26, it would be obvious to report a peak utilization to better study the program to ensure its smooth operation.

As to claim 29, it would be obvious to bill the entity leasing the hardware as they are responsible for it.

As to claim 30, the lessee would enquire about getting service with the company.

As to claim 31, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claim 42, the periodic rate would be considered a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 43, it would be obvious to check the configuration is the same so as to ensure that it is the correct user using the system and not a so-called "hacker".



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As to claim 46, where the products are installed is considered to be a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 49, Carnegie does not specifically teach that the acquiring means is a stand-alone computer. This would be a matter of obvious design choice, as it is merely another variation on the computer taught by Carnegie, and would not make the invention patentably distinct.

As to claim 55, it would have been obvious to test transport means to ensure that the customer is billed properly.

As to claim 56, the system uses email (col 9, lines 1-6).

As to claim 57, it would be obvious to test the device to ensure that it has not received a virus.

As to claim 58, the known response would prove that the user has an account (fig 3).

As to claim 59, it would have been obvious to one of ordinary skill in the art to use the metering engine to check the known response as the metering agent is used in setting charges.

As to claim 60, the device uses the Internet (fig 1).

As to claim 61, the Internet is a digital, data, communications network.

### ***Response to Arguments***

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Applicant's arguments filed 1/8/07 with respect to claims 2,11, 15 and 17 have been fully considered and are persuasive. The rejection under 35 U.S.C. 112 of these claims has been withdrawn.

Applicant's further arguments filed 1/8/07 have been fully considered but they are not persuasive. As to arguments in relation to claim 47, the examiner will direct applicant to claim 46, from which claim 47 depends, "...hardware products...for installation at a client site." And claim 47, "...where the client site is.... on a digital communications network.". Therefore, the hardware is installed at the client site and the client site is on a digital network, therefore, the hardware is installed on a digital communications network, therefore, hardware is installed on software, therefore, the rejection under 35 U.S.C. 112 is deemed proper.

As to arguments that it is not old and well known for metering equipment to be attached on a telephone, the examiner specifically mentioned the original Bell telephone as they did not provide specialized long distance services that are available today. You called the number and you were charged for the time you spent on the long distance call and therefore, Bell billed customers based on usage (i.e. long distance), therefore, there would inherently and necessarily be metering equipment else bills could not be accurate. As to arguments in relation to Carnegie, the act of recording a connection is metering. The claims do not limit the metering to any specific criteria but merely to "operation at the one or more products" (from claim 1), therefore, Carnegie meets the limitations as claimed. Further, applicant is again directed toward US PAT 6,882,439.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

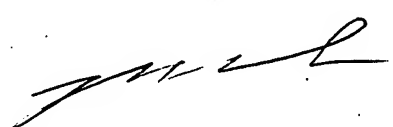
The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

3/19/07

  
JOHN G. WEISS  
SUPERVISOR, EXAMINER  
ELECTRONIC BUSINESS CENTER 3600